

REMARKS

In the Office Action, claims 1-37 were rejected as in a previous Office Action as unpatentable under 35 U.S.C. §103(a) over DiRienzo in view of Howards Koritzinsky et al. Applicant resubmits that the claims are patentable over the cited references because the Howards Koritzinsky et al. reference is disqualified as prior art under 35 U.S.C. §103(c).

In responding to the previous Office Action, the undersigned represented that the present invention and the application, now a U.S. Patent, to Howards Koritzinsky et al. were commonly assigned at the time the presently claimed invention was made. The Examiner, however, maintained the rejection stating that no assignment of record could be located for the Howards Koritzinsky et al. patent.

It is correct that at the time of this writing, no recorded Assignment has yet been recorded in the U.S. Patent & Trademark Office for the Howards Koritzinsky et al. patent. However, no recorded assignment is required by the statute. Rather, 35 U.S.C. §103(c) states:

35 U.S.C. - Conditions for Patentability; Non-Obvious Subject Matter

(c) Subject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not be deemed patentable under this section where the subject matter and the claimed invention were at the time the invention was made, owned by the same person or *subject to an obligation of assignment* to the same person. (Emphasis added)

Application of this rule is governed by MPEP §706.02 and its subsections. In particular, the applicable and current practices require that a clear and conspicuous statement be made of the common ownership or obligation of assignment. This statement was made in the previous response by the Applicant. The MPEP also

notes that evidence of common assignment may be provided, but is not required. See MPEP 706.02(l)(2) heading II.

The italicized portion of §103(c) above is highlighted here to remind the Examiner that there is no requirement that assignments be recorded in the Patent & Trademark Office. Indeed, Section 103(c) applies with equal force to situations where no such assignment has been recorded, or even formally made. The clear and conspicuous statement required by the rules has been made, and the representation of the undersigned that the Howards Koritzinsky et al. reference is under an obligation of assignment to the same assignee as the present application is of record. Accordingly, the Howards Koritzinsky et al. reference is disqualified as prior art under 35 U.S.C. §103(c).

In the event the Examiner wishes to discuss the situation surrounding the Howards Koritzinsky et al. reference or the present application, or requires further verification or evidence of the assignment or obligation of assignment of the reference, he is kindly asked to contact the undersigned at his earliest convenience.

In view of the disqualification of the Howards Koritzinsky et al. reference,
the single rejection formulated by the Examiner cannot stand. Accordingly,
Applicants submit that the pending claims are patentable over the prior art, and
requests their reconsideration and allowance.

Respectfully submitted,

Date: 3/22/2004

Py
Patrick S. Yoder
Reg. No. 37,479
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545